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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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27573	7590	10/24/2006		
CEPHALON, INC. 41 MOORES ROAD PO BOX 4011 FRAZER, PA 19355				
			EXAMINER FUBARA, BLESSING M	
			ART UNIT 1618	PAPER NUMBER

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,350

Applicant(s)

JACOBS ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-51 and 55-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-51 and 55-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/4/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of request for extension of time, IDS, amendment and remarks, all filed 8/04/06. Claims 1-4, 8, 10, 11, 14, 15, 19, 32, 36-38, 40, 42, 43, 44, 51, 55, 57 and 58 are amended. Claims 1-4, 8-51, 55-58 and new claims 59-65 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The rejection of claims 1-4, 32, 33, 36, 37, 39, 41-44, 47, 48, 51 and 58 under 35 U.S.C. 102(b) as being anticipated by Grebow et al. (US 5,618,845) is withdrawn in view of applicant's persuasive argument that Grebow's composition does not implicitly or explicitly contain surfactants since emulsions do not always contain surfactant according to what is known in the art (Merriam-Webster Dictionary and US 4,151,143 cited by applicant in support of the position that emulsions may not contain surfactants).

Response to Arguments

3. Applicant's arguments filed 08/04/06, with respect to Grebow have been fully considered and are persuasive. The rejection of claims 1-4, 32, 33, 36, 37, 39, 41-44, 47, 48, 51 and 58 has been withdrawn.

4. Claims 1, 3, 4, 11, 14, 15, 32, 33, 47 and 51 remain rejected under 35

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U.S.C. 102(b) as being anticipated by Nguyen et al. (US 5,843,347).

Nguyen teaches a pharmaceutical composition comprising particles or microparticles of active ingredient, physiologically acceptable hydrophilic excipient and water (abstract). The hydrophilic excipient comprises a polymer component and a water-soluble or water dispersible component that acts as a diluent (column 6, lines 1-5). The polymer component is selected from the group consisting of gum Arabic, xanthan gum, gum tragacanth, alginates, pectinates, polyvinylpyrrolidone, polyethylene glycols, cellulose, carboxymethyl cellulose, cellulose ethers, carboxymethyl chitin, dextran, chitosan, gelatin, acrylic and methacrylic polymers and copolymers, colloidal silica and mixtures thereof (column 6, lines 11-23). The water-soluble or water dispersible component is selected from the group consisting of lactose, glyccoll, mnnnitol, glucose, sucrose, maltodextrin, cyclodextrins and derivatives thereof (column 6, lines 44-49). The hydrophilic excipients can also comprise surfactants that are capable of oral administration and the surfactants can be polysorbates, sorbitan esters, fatty glyceride polyethers, lecithins, sodium lauryl sulfate, sodium dioctylsulfosuccinate and mixtures thereof (column 7, lines 2-7). The process of preparing the modafinil particles involves homogenization of the active ingredient in solution, suspension, or emulsion and freeze-drying or lyophilization (column 8, lines 15-24). The active ingredient is selected from the group consisting of paracetamol, probucol, piroxicam, phloroglucinol, tiadenol, flerobuterol, modafinil, dexfenfluramine, carbinoxamine maleate, loperamide, lorazepam and mixtures thereof (claim 13). Oral administration is route of administration and route of administration of a composition is does not patentably distinguish the claimed composition over the prior art.

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Nguyen does not exclude stable emulsion, Nguyen does not teach that the emulsion is unstable. However, and since Nguyen homogenizes and lyophilizes the emulsion, the lyophilized product would be stable. The composition of Nguyen contains polyethylene glycol and the polyethylene glycol meets the limitation of the claimed solvent. The method steps in claims 36 and 37 broadly contacts modafinil particles with water and the composition of Nguyen contains water. Thus Nguyen clearly teaches the composition and the methods of the application in the claims designated above. Therefore, the teachings of Nguyen meet the limitations of the claims.

Response to Arguments

5. Applicant's arguments filed 8/04/06 have been fully considered but they are not persuasive.

Applicant argues that Nguyen fails to disclose a composition that spontaneously forms an aqueous homogeneous, stable composition when contacted with an aqueous medium. Applicant asserts that the language of "spontaneously form" is a characteristic of the composition and to support this language as having patentable weight, applicant cited US 7,070,803; 7,053,034; 7,067,152; 7,063,862; and 6,231,888; all of which contains claims directed to products/compositions having certain characteristics. Applicant further argues that independent claim 36 contains limitations of "spontaneously" and "liquid," and that Nguyen fails to disclose those limitations.

Response:

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Examiner agrees with applicant that “spontaneously form” is a characteristic of the composition and since the prior art composition meets the limitation of the claimed composition and would therefore inherently possess the characteristic spontaneously forming an aqueous liquid composition when placed in contact with aqueous. Same composition must have same properties. Regarding the pasty mixture of the composition of Nguyen, which is further extruded and freeze dried, it is noted that claim 1 does not claim a specific form of the composition except that when contacted with aqueous medium, the composition spontaneously form a liquid composition. The composition of Nguyen would inherently have that characteristic.

Since amended claims 2, 36, 37 and 39 require the form of the composition to be a liquid, these claims are not included in the above rejection. Therefore, applicant's remarks with regards to amended claims 2, 36 and 37 are moot in view of the withdrawal of these claims from the above rejection.

Claim Rejections - 35 USC § 103

6. Claims 8-10, 12, 13, 16, 17-31, 34, 35, 38 and 40-46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US 5,843,347) in view of Lafon (US 5,180,745). New claims 60 and 61 are included in this rejection. Therefore, claims 8-10, 12, 13, 16, 17-31, 34, 35, 38, 40-46, 60 and 61 remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US 5,843,347) in view of Lafon (US 5,180,745).

Nguyen is discussed above. However, Nguyen fails to teach administering the composition to a subject in need thereof to treat any of the conditions recited in claim 44.

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But, Lafon teaches a method of treating Parkinson's disease where the method comprises administering to a patient in need thereof a therapeutically effective amount of modafinil (claim 1). For modafinil to be effective in treating Parkinson's disease, the modafinil administered must be carried by the blood to the target areas, which implies that the level of modafinil in the blood serum is effective for treating the Parkinson's disease. In the absence of a showing to the contrary, modafinil blood serum levels of 0.05 to 30 µg/ml do not patentably distinguish the invention over the prior art.

Parkinson's disease is one of the conditions recited in claim 44. Lafon teaches that the dose administered to humans varies from 50 mg to 1000 mg (column 1, lines 33 and 34). The dose of 200 mg and 100 mg recited in claims 34 and 35 lie within the disclosed range of 50-1000 mg. It would have been obvious to one of ordinary skill in the art at the time the invention was made to orally administer the composition of Nguyen to treat Parkinson's disease because Lafon administers modafinil to treat the disease. One having ordinary skill in the art would have been motivated to treat Parkinson's disease by administering to a subject in need of treatment the composition of Nguyen where the modafinil dose is 50 mg to 1000 mg because Lafon teaches that the dose of modafinil administered to humans varies from 50 mg to 1000 mg.

Response to Arguments

7. Applicant's arguments filed 8/04/06 have been fully considered but they are not persuasive.

Applicant argues that Nguyen's composition is limited to a pasty mixture that can be extruded and cut into regular shape and that Nguyen does not suggest that the composition forms a liquid. Applicant asserts that because Nguyen fails to disclose a

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composition that forms a liquid when placed in contact with aqueous medium, Nguyen in view of Lafon does not render the rejected claims obvious.

Response:

Claim 1 is not directed to any specific form of the composition except that the composition when placed in contact with aqueous medium forms a liquid. However, Nguyen discloses the limitations of the instant composition and would therefore have the characteristics recited in the claims. Therefore, Nguyen in view of Lafon renders the rejected claims.

8. Claims 2, 36-39, 48-50 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US 5,843,347) and Grebow et al. (US 5,618,845).

Nguyen is described above as containing modafinil and surfactant and solvent. Nguyen's composition is not a liquid.

Grebow teaches a pharmaceutical composition comprising modafinil particles or modafinil pharmaceutically acceptable salt particles (abstract, column 2, column 3, lines 1-55 and claims 1 and 2) and non-toxic pharmaceutically acceptable carrier (column 4, lines 4-1%). Grebow's composition contains an appropriate dosage of between 50 mg and 700 mg of modafinil with a preferred amount of 400 mg (column 4, lines 11-18 and column 10, lines 15-17). The modafinil pharmaceutical composition is administered as a tablet, capsule, powder, pill, liquid, suspension or emulsion; the modafinil composition can also be administered topically via epidermal patch or administered via direct injection (column 10, lines 18-26). Grebow further teaches a method of altering somnolent state, for example, narcolepsy, idiopathic hypersomnia and related sleep disorders by administering to a mammal a pharmaceutical composition comprising an effective amount of modafinil particles; and an effective amount of

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the pharmaceutical composition is defined as an amount effective for treating the somnolent state (column 3, lines 56-67). In human clinical trials, modafinil is administered to physically and mentally healthy male subjects (column 5, lines 46 to 56).

The composition of Grebow encompasses stable and unstable suspensions because the prior art does not exclude stable suspensions and thus the suspension of Grebow would be inherently stable. It is also noted that Grebow discloses suspensions containing modafinil and in the suspension modafinil is not crystalline and the particles of modafinil are suspended in the solvent. The composition of Grebow can also be administered as a liquid as described above.

Grebow also teaches administering the prior art composition in clinical trials to mentally and physically healthy male subjects. Orally administering modafinil particles to human subjects (column 5, lines 46-56) would necessarily bring modafinil particles in contact with the aqueous environment in the human subject since human body is mostly water. the prior art is silent on the form of the capsule. Since the prior art is silent on the form of the capsule, hard or soft gelatin capsule, the prior art broad teaching of a capsule encompasses both soft gelatin capsule or hard capsule. The expected result would be a modafinil particle composition encapsulated in soft gelatin capsule or hard capsule. Therefore, regarding soft or hard capsule, one of ordinary skill in the art is capable of encapsulating the composition in hard or soft in hard capsule or soft gelatin capsule.

Since Nguyen does not disclose a liquid form of the composition and Grebow discloses that modafinil composition can be administered as liquid, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make and use the modafinil composition of either Nguyen or Grebow. One having ordinary skill in the art would have made

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a combined formulation Nguyen as a solid or as a liquid for administration with the expectation that effective amount of the modafinil would be delivered.

9. Claims 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US 5,843,347) and Grebow et al. (US 5,618,845) in view of Lafon (US 4,927,855).

Nguyen and Grebow are discussed above. Grebow suggests that modafinil is known to be used in the art for treating Alzheimer (column 10, lines 40-44), and also discloses in the background section at column 1, lines 61-64, that the levorotatory form of modafinil is used to treat other diseases including Alzheimer. The composition of Grebow does not contain the levorotatory form of modafinil. Therefore, the combined composition of Nguyen and Grebow does not contain modafinil. However, Lafon discloses that the levorotatory form of modafinil is useful in the treatment of Alzheimer (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the pharmaceutical combined composition of Nguyen and Grebow for use in the treatment of Alzheimer. One having ordinary skill in the art would have been motivated by Lafon to prepare the combined composition of Nguyen and Grebow with the levorotatory form of modafinil and use the preparation to treat Alzheimer with the expectation that as disclosed by Lafon, the levorotatory modafinil would be effective in the treatment of Alzheimer.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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11. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 59 recites molecular weight of about 1500 less and it is not clear what the units of the molecular weight may be. Clarification is required.

No claim is allowed.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594.

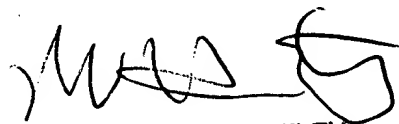
The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bf

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SUPERVISORY PATENT EXAMINER